

Notice of Allowability

Application No.

09/992,167

Examiner

Hector M Reyes

Applicant(s)

IKEMOTO ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/03/03.
2. ☒ The allowed claim(s) is/are 1,2, 4-13 and 15 to 28, renumbered as 1-26.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

Status of the Claims

Claims 3 and 14 have been canceled. Claims 1, 2, 4, 5, 10, 11, 13, 16, 20-25 and 26 have been amended. Currently, claims 1, 2, 4-13, 15-28 are under examination. The said active claims have been renumbered as claims 1-26.

Allowance

The following is an examiner's statement of reasons for allowance: Applicants claim:

- In claims 1-2, a series of esters derivatives having the formula II
- In claims 4-9, a method for the preparation of compounds of formula II
- In claims 10-11, a method for the preparation of ester of formula III via reduction of compound II
- In claims 12-13 a method for the preparation of acid of formula V via hydrolysis of compound of formula II
- In claims 15-19, a method for the preparation of acid of formula IV from hydrolysis and reduction of compound of formula II
- In claim 20-21, a method for the preparation of compound of formula III from reduction of compound of formula II
- In claim 22-23, a method for the preparation of compound of formula V via hydrolysis of compound of formula II
- In claims 24-28, a method for the preparation of compound of formula IV, via hydrolysis and reduction of compound of formula II.

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No prior art disclosing or suggesting the claimed instant process was found in the prior art. The closest art relevant to the instant invention was found in EP 1205464 (2002).

The said EP patent discloses the same compounds and methods of the instant invention.

Nonetheless, the said reference is not prior art because:

- It is the work of the same inventors
- The instant invention has a filing date previous to the said patent and
- Both, the instant invention and EP 1205464 claim foreign priority to the same Japanese patent: JP 339437/200.

CONCLUSION

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee.

Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

All post-Allowance Correspondence concerning this Application must be mailed to:

**BOX ISSUE FEE
COMMISSIONER FOR PATENTS
WASHINGTON, DC 20231**

**Héctor M. Reyes, PhD JD
Reg. # 54,846
Art Unit 1625
March 18, 2004**



**RITA DESAI
PRIMARY EXAMINER**